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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,305	01/22/2002	Rudor M. Teich	2765-009	5383

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EXAMINER	
HAMILTON, KIMBERLY Y	
ART UNIT	**PAPER NUMBER**
2635	4

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/054,305	TEICH, RUDOR M.	
	Examiner	Art Unit	
	Kimberly Hamilton	2635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 June 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 January 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *6-29-2002*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: on pg. 3, line 21, a period is missing after the word "**addition**". Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-25 of Application No. 10/05305 (hereinafter '305) are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 8-13, 16-21, 24-29, 31-36 of copending Application No. 10/054306 (hereinafter '306). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application has broader claims wherein the claims of 10/054306 have narrow claims, which constitute double patenting. See *In re Van Ornum and Stang, 214, USPQ 761, 766, and 767* (CCPA) (the court sustained an obvious double patenting rejection of generic claims in a continuation application over narrower species claims in an issued patent; *In re Vogel, 164 USPQ 619, 622 and 623* (CCPA 1970) (generic application claim specifying "meat" is obvious double patenting of narrow patent claim specifying "pork").

Regarding claims 1, 6, 11, 16, and 21 of '305, Teich specifies in the claims:

- a means for automatically changing the identification code of a transmitter when the transmitter is to have its identification code added to the receiver list **(automatically changing id)** the transmission when an identification code is to be added to the receiver list is different in form from the transmission when an identification code is not to be added to the receiver list **(implied means for changing mode, form of modes is different, controlling addition in the receiver).**

Whereas in '306, Teich specifies the limitations in claims 9, 10, 23, 31, and 32:

- a means for placing the transmitter in an operate mode and a teach mode **(means for changing modes),**
- the transmitter transmitting its identification code in both modes but the forms of transmission being different in the two modes, and **(form of modes is different)**
- means in the receiver for controlling the addition of a received authorization code to the receiver list only if the form of the received transmission is that of a transmitter teach mode **(controlling addition in the receiver).** Thus, it would have been obvious to one of ordinary skill in the art at the time of invention recognize transmitting in teach mode or operate mode as transmitting in a normal or changed form and recognize that changing a transmitting forms is a broader recitation of teach and operate modes, wherein the instant application teaches a broader limitation of modes different, which are specified in application '306.

Regarding claims 2, 7, 12, 17, and 22 of '305, Teich specifies the following limitations in the claims: a new identification code is randomly generated and cannot be traced to the previous identification code.

As shown in application '306, Teich specifies identical limitations in claims 3, 11, 19, 27, and 33.

Regarding claims 3, 8, 13, 18, and 23 of '305 (hereinafter '305), Teich teaches a remote control system wherein:

- the identification code of a transmitter is automatically changed when the transmitter is to have its identification code added to the receiver list (**code changing**)
- wherein the transmission when an identification code is to be added to the receiver list is different in form from the transmission when an identification code is not to be added to the receiver list (**placed in different modes, forms different, operates to add when in certain mode**).

As shown in '306, claims 1 and 2, 17 and 18, 25 and 26 specify the following limitations:

- a transmitter can be placed in an operate mode and a teach mode (**placed in different modes**),
- the transmitter transmitting its identification code in both modes but the forms of the transmission being different in the two modes (**forms different**), and
- the receiver operates to add a received authorization code to its list only if the form of the received transmission is that of a transmitter teach mode (**operates to add when in certain mode**).
- the identification code of a transmitter is automatically changed when the transmitter is to have its identification code added to the receiver list (**code changing**). Although the limitations of '305 are broader regarding different modes, application '306 specifies the teach mode and operate mode; thus being different modes. Henceforth, it would have been obvious to one of ordinary skill in the art at the time of invention to recognize the two modes being a teach mode and an operation mode

in application '305 as stated in application '306, because the defining of teach and operate modes in application '305 only gives titles to the different transmitting forms of application '305, which as shown above.

Regarding claims 4, 9, 14, 19, and 24 in '305, Teich specifies the limitations: the identification code of a transmitter is automatically changed, transmission is in a different form a number of times but with the same changed identification code. However, '305 does not include the limitation of the recitation of a teach mode.

As shown in claims 4, 12, 20, 28, and 34 of '306, Teich specifies the aforementioned limitations of the identification code of a transmitter that automatically changes, wherein the transmission is in a teach form, and is transmitted for a number of times. Henceforth, it would have been obvious to one of ordinary skill in the art at the time of the invention to recognize that the teach form/mode of '306 is narrower than the limitation of '305 as being a different form.

Regarding claims 5, 10, 15, 20, and 25 in application '305, Teich speicifies the limitations: the identification code of a transmitter is automatically changed, for a number of times transmission is in a form different from the identification. However '305 does not give the recitation of a teach or operation mode.

However, claims 5, 13, 21, 29, and 35 of application '306 specifies the limitations as aforementioned. In addition, the above claims include the limiations of both the teach mode and the operation mode. Henceforth, it would have been obvious to one of ordinary skill in the art at the time of invention to recognize transmitting in a teach mode as transmitting in a changed form and recognize that changing a transmitting form is a broader recitation of teach mode as detailed above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3, 6, 8, 11, 13, 16, 18, 21, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Heitschel et al. (US 4750118).

Regarding claims 1, 6, 11, 16, and 21, Heitschel, who discloses a coding system for multiple transmitters for a single receiving device, teaches a remote control system having a receiver 41 and one or more transmitters 26 and 28 (Fig. 2). Heitschel teaches that each transmitter transmitting a respective identification code (unique code that is changeable col. 1, lines 34-39). In addition, Heitschel teaches the receiver as having a list (in memory address storage 47) identification codes associated with authorized transmitters, the receiver being operable in a learn mode (program mode) during which it may receive a transmitted identification code for addition to its list (col. 3, lines 35-40), the improvement in which the identification code of a transmitter is automatically changed when the transmitter is to have its identification code added to the receiver list (col. 1, lines 34-39).

Regarding claims 3, 8, 13, 18, and 23, Heitschel teaches a remote control system wherein the transmission when an identification code is to be added to the receiver list is different in form (mode) from the transmission when an identification code is not to be added to receiver list in that the unique code is stored into the memory of the receive when the form (mode) is in learn/program mode, and the identification code must be received for a number of

time before being stored in memory (col. 4, lines 28-30). Furthermore, the second mode is the operation mode wherein the control system is actuated (col. 4, lines 36-43).

Regarding claims 4, 9, 14, 19, and 24, Heitschel teaches, as aforementioned, a remote control system wherein after the identification code of a transmitter is automatically changed (col. 1, lines 34-36), and transmission is in different form (program mode) a number of times (four) but with the same changed identification code (col. 4, lines 28-30).

Regarding claims 5, 10, 15, 20, and 25, Heitschel teaches a remote control system wherein after the identification code of a transmitter is automatically changed (col. 1, lines 34-36), for a number of times (four) transmission is in a form different (operation mode) from the transmission when an identification code is not to be added to receiver list but with the same changed identification code (col. 4, lines 17-20).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 2, 7, 12, 17, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heitschel in view of Waggamon et al. (US 6049289).

Regarding claims 2, 7, 12, 17 and 22 Heitschel teaches a remote control system wherein the identification code of the transmitter is changeable (col. 1, lines 34-36); however, Heitschel does not expressively disclose the previous identification code as being untraceable.

However, Waggamon, who discloses a remote controlled garage door opener that includes on receiver and one or more transmitters, discloses that every transmitter has a

different serial number and a unique "secret" key (identification code) (col. 2, lines 47-49). In addition, Waggamon teaches that each time the transmitter is activated; the code automatically changes (col. 2, lines 49-52). Henceforth, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the code hopping of Waggamon into the remote device of Heitschel, because Heitschel teaches a remote control system wherein the identification code of the transmitter is changeable (col. 1, lines 34-36), and Waggamon teaches that the transmitter's code changes after each activation (col. 2, lines 49-52). One of ordinary skill in the art knows that code hopping is a beneficial method to utilize as a means to prevent theft or code "grabbing" from unauthorized users.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Clark et al. (US 5418159) teaches a remote control system with learn/teach mode for identification code setting.
- Tsui (US 5680134) teaches a remote transmitter-receiver control system.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly Hamilton whose telephone number is 703.305.8975. The examiner can normally be reached from Monday – Friday between the hours of 7am - 3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703.305.4704. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kimberly Hamilton
Examiner
Art Unit 2635
10 May 2004

KYH

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